IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 9152
Donald S. Krysinski et al.	Examiner: Loftis, Johnna Ronee
Application No.: 09/929,398	Technology Center/Art Unit: 3623
Filed: August 14, 2001	APPELLANTS' BRIEF UNDER 37 CFR §41.37
For: AUTOMATED BUSINESS MACHINE MANAGEMENT	

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on January 10, 2007 for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

At the time of the filing of this Appeal Brief, the real party in interest is MWA Intelligence, Inc, which acquired the rights to this patent application through the acquisition of Imaging Portals, Inc. Imaging Portals, Inc. acquired the rights to this patent application through the acquisition of CopiersNow (the current assignee).

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-14, 17-24, 26 and 28 are currently pending in the application, but stand rejected by the Examiner. Claims 1-27 were originally filed in the application on August 14, 2001. Claim 28 was added and claims 15, 16, 25, and 27 were canceled in an Amendment dated June 1, 2006, filed in response to the Non-Final Office Action mailed March 1, 2006.

Claims 1-14, 17-24, 26 and 28 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

After a Final Office Action was mailed August 14, 2006 (hereinafter "Final Office Action"), a Response was filed November 21, 2006, but the claims were not amended.

An Advisory Action was mailed November 30, 2006 (hereinafter "Advisory Action"), and in response a Notice of Appeal was mailed January 10 2007.

No amendments remain unentered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37

C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only. Claims 1, 14, 22, and 28 are the independent claims.

Claim 1 recites a method for automating management of a service contract for a business machine associated with a user. A data capture device 116 is in communication with a business machine 112, which may be a copier, a printer, a fax machine, a scanner, or any combination thereof. Original Application, p. 3, ll. 9-11, 25-26; p. 5, ll. 10-11; Figs. 1A and 1B, ref. nums. 112, 116. A threshold event associated with the service contract is automatically determined, the threshold event comprising a usage count, a detected error, a predetermined time period, or any combination thereof. Id., p. 3, ll. 4-6; p. 3, l. 33 - p. 4, l. 3; p. 10, ll. 5-6. The threshold event is programmed into the data capture device, and the data capture device monitors the business machine to log an occurrence of the threshold event. Id., p. 4, ll. 25-27; p. 5, ll. 12-16; p. 13, l. 20. Notification is received from the data capture device indicating that the threshold event was logged, and the logging of the threshold event triggers the notification. Id., p. 5, ll. 19-28; p. 10, ll. 27-28; p. 11, ll. 14-15; p. 13, l. 20. Information related to the service contract is reported electronically and automatically to the user based, at least in part, upon the notification. Id., p. 10, ll. 19-22.

Claim 14 recites an automated business machine management system for business machines of users. The system includes a number of data capture devices 116 each coupled to an associated business machine 112 (e.g., a copier, a printer, a fax machine, a scanner, or any combination thereof). Id., p. 3, ll. 9-11, 25-26; p. 5, ll. 10-11; Figs. 1A and 1B, ref. nums. 112, 116.. Each data capture device includes a wireless transceiver. Id., p. 4, ll. 4-10.

The system of claim 14 also includes an operations center 104 in two-way communication with each of the plurality of data capture devices 116. Id., p. 3, ll. 17-21, 31-33; Figs. 1A and 1B, ref. num. 104. The operations center determines a threshold related to a service contract (e.g., a usage count, a detected error, a predetermined time period, or any combination thereof), and communicates that threshold to one of the plurality of data capture devices. Id., p. 3, l. 33 - p. 4, l. 3; p. 10, ll. 5-6. The system of claim 14 also includes a web interface 108 to the

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operations center. Id., p. 3, ll. 16-17; p. 6, ll. 3-4; Figs. 1A, 1B, and 3, ref. num. 108. The web interface is remote to the operations center and allows users to remotely interact with service contract information and thereby modify the threshold. Id., p. 3, l. 33 - p. 4, l. 3; p. 12, ll. 10-12.

Claim 22 recites an alternative method for automating management of a service contract for a business machine associated with a user. A data capture device is provided next to a business machine (e.g., a copier, a printer, a fax machine, a scanner, or any combination thereof). Id., p. 3, ll. 9-11, 25-26; p. 5, ll. 10-11; Figs. 1A and 1B, ref. nums. 112, 116. A threshold event associated with the service contract is automatically determined, the threshold event comprising a usage count, a detected error, a predetermined time period, or any combination thereof. Id., p. 3, ll. 4-6; p. 3, l. 33 - p. 4, l. 3; p. 10, ll. 5-6. The threshold event is programmed into the data capture device, and the data capture device monitors the business machine to log an occurrence of the threshold event. Id., p. 4, ll. 25-27; p. 5, ll. 12-16; p. 13, l. 20. Notification is received from the data capture device indicating that the threshold event was logged, and the logging of the threshold event triggers the notification. Id., p. 5, ll. 19-28; p. 10, ll. 27-28; p. 11, ll. 14-15; p. 13, l. 20. In response to the notification from the data capture device, a technician is automatically and wirelessly notified to service the business machine. Id., p. 5, ll. 3-9; p. 5, l. 33 - p. 6, l. 2; p. 10, ll. 5-6.

Claim 28 recites an alternative embodiment of an automated business machine management system for business machines of users. The system includes a number of data capture devices 116 each coupled to an associated business machine 112 (e.g., a copier, a printer, a fax machine, a scanner, or any combination thereof). Id., p. 3, ll. 9-11, 25-26; p. 5, ll. 10-11; Figs. 1A and 1B, ref. nums. 112, 116. Each data capture device is configured to monitor its associated business machine and to log monitored events, and includes a wireless transceiver. Id., p. 4, ll. 4-10, 25-26; p. 13, l. 20.

The system of claim 28 also includes an operations center 104 in two-way communication with each of the plurality of data capture devices 116. Id., p. 3, ll. 17-21, 31-33; Figs. 1A and 1B, ref. num. 104. The operations center determines a threshold related to a service contract (e.g., a usage count, a detected error, a predetermined time period, or any combination

thereof), and communicates that threshold to one of the plurality of data capture devices. Id., p. 3, l. 33 - p. 4, l. 3; p. 10, ll. 5-6. The operations center receives wireless notification the data capture device that the threshold was logged by the one data capture device, triggering the notification. Id., p. 3, ll. 31-33; p. 4, ll. 4-10. In response to the notification from the data capture device, a technician automatically and wirelessly notifies a technician to service the business machine. Id., p. 5, ll. 3-9; p. 5, l. 33 - p. 6, l. 2; p. 10, ll. 5-6. The system of claim 28 also includes a web interface 108 to the operations center. Id., p. 3, ll. 16-17; p. 6, ll. 3-4; Figs. 1A, 1B, and 3, ref. num. 108. The web interface is remote to the operations center and allows users to remotely interact with service contract information and thereby modify the threshold. Id., p. 3, l. 33 - p. 4, l. 3; p. 12, ll. 10-12.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Whether under 35 U.S.C. §102(b) claims 1, 2, 7-9, 12 and 13 are anticipated by Tarr et al., U.S. Patent 5,184,179 ("Tarr").

Ground of Rejection II: Whether under 35 U.S.C. §103(a) claims 3-6, 10, 11, 14, 17-24, 26 and 28 are unpatentable over Tarr and Official Notice.

7. ARGUMENT

Ground of Rejection I:

35 U.S.C. §102(b) rejection of claims 1, 2, 7-9, 12 and 13

The Final Office Action rejected independent claim 1 as anticipated by Tarr. For a valid anticipation rejection, the Office must show that each limitation from a claim appears in a single piece of prior art. Appellants believe significant limitations from independent claim 1 are neither taught nor suggested in the cited references.

More specifically, Tarr fails to teach or suggest "reporting information related to the service contract electronically and automatically to the user," as recited in claim 1. The Final Office Action cites a portion of Tarr specifying notification to the billing computer "operator" when maintenance is required. Final Office Action, p. 3, ll. 15-17, citing Tarr, col. 6, ll. 20-23.

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The "billing computer operator" of Tarr is different than the business machine user recited in claim 1. This part of Tarr clearly does not teach the limitation at issue.

As the cited reference fails to teach or suggest all of the recitations of claim 1, Appellants submit that claim 1 is allowable. Claims 2, 7-9, 12 and 13, which depend from claim 1, are allowable for at least the same reasons. Claims 3-6, 10, and 11 also depend from claim 1, and are allowable for at least the same reasons. Therefore, Appellants respectfully request the rejections to claims 1-13 be reversed.

Ground of Rejection II:

35 U.S.C.§103(a) rejections of claims 3-6, 10, 11, 14, 17-24, 26 and 28

The Final Office Action rejected independent claims 14, 22, and 28 under 35 U.S.C. §103(a) as being unpatentable over Tarr and official notice. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143.

Appellants believe significant limitations from the independent claims are neither taught nor suggested in the references. More specifically, neither Tarr nor Official Notice can be relied upon to teach or suggest (1) automatic wireless notification of a service technician, as recited by at least claims 22 and 28, (2) an operations center that communicates the service triggering threshold, as recited by at least claims 14 and 28, (3) a data capture device at a business machine with a wireless transceiver that transmits a notification to the operations center when the threshold is triggered, as recited at least in claim 28, or (4) a web interface allowing users to remotely interact with service contract information and thereby modify the triggering threshold, as recited in claim 14 and 28. Appellants respectfully request that the obviousness rejection be withdrawn for these reasons.

1. Automatic Wireless Notification: Tarr cannot reasonably be relied upon to teach *automatic wireless notification of a service technician* in response to receiving notification of a threshold event from the data capture device on a business machine.

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There is no *automatic wireless* notification of the service technician, as called for in the claims. Final Office Action, p. 12, ll. 2-3, citing Tarr, col. 8, ll. 20-24. Both claims 22 and 28 recite that the **"wireless notifying occurs automatically** in response to the notification from the data capture device" (emphasis added).

But the Office relies on a passage of Tarr that states "upon receipt of the diagnostic signal the central station then dispatches a service person and informs the service person of the nature of the problem and the requisite tools and parts." Tarr, col. 8, ll. 20-24. This falls short of the *automatic wireless notification* of a service technician recited in the claims (emphasis added).

Moreover, the Final Office Action dated August 14, 2006 ("Office Action") merely appears to take Official Notice of the wireless aspects of this step (Office Action, p. 12, ll. 6-10). Appellants traverse this Official Notice.

The MPEP provides that Official Notice without documentary evidence is only appropriate in "**rare**" cases, a caveat that was not followed in this instance. MPEP §2144.03(A). "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." *Id.*

It is respectfully suggested that automatic wireless notification of a service technician in response to the triggering of a threshold at a business machine is not capable of instant and unquestionable demonstration as being well-known. Appellants have therefore "specifically point[ed] out the supposed errors in the examiner's action." MPEP §2144.03(C).

In the Advisory Action dated December 22, 2006 ("Advisory Action"), the Office also cites a portion of Tarr stating that a "service person may be equipped with a portable hand held input/output device 34 in the form of a keypad/display which may become part of the system through an auxiliary input 22a of monitoring CPU 24." Advisory Action, p. 2. It appears that the Office may be relying on this passage to suggest the wireless notification of the service technician recited in the claims. But this part of Tarr suggests a physical "plug-in" to the

monitoring device of Tarr, not a wireless device to allow a service technician to receive wireless notification. See Tarr, col. 8, ll. 25-43.

2. Operations Center: Tarr cannot reasonably be relied upon to teach an *operations center* that *communicates* the service triggering *threshold* to a data capture device on a business machine. Claim 14 recites "an operations center [that] determines a threshold related to a service contract and communicates that threshold to one of the plurality of data capture devices." Claim 28 contains similar limitations.

The Final Office Action relies on a section of Tarr to teach this limitation that clearly does not do so. Final Office Action, p. 11, ll. 17-19, citing Tarr, col. 5, ll. 14-30. The Office states that a "billing computer automatically receives the necessary information to produce bills," and that this equates with the limitation at issue.

But in claims 14 and 28, " an operations center determines a threshold related to a service contract and communicates that threshold to *one* of the plurality of *data capture devices*" (emphasis added). This is very different than a *billing computer* automatically receiving information to produce bills.

3. Wireless Transceiver at Business Machine: Tarr cannot reasonably be relied upon to teach a data capture device at a business machine with a *wireless transceiver* that *transmits a notification* to the operations center when the *threshold* is triggered, as recited in claim 28 (emphasis added). A similar limitation is found in claim 14.

The Office Action merely appears to take Official Notice of this element (Office Action, p. 12, ll. 6-10). Appellants traverse this Official Notice.

It is respectfully suggested that before the priority date of this Application, attaching a wireless transceiver to data capture device coupled with a business machine was not capable of instant and unquestionable demonstration as being well-known. In the present context, this is yet another novel aspect of a new methodology of managing business machines.

Appellants have therefore "specifically point[ed] out the supposed errors in the examiner's action." MPEP 2144.03(C).

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4. Web Interface: Appellants also traverse Official Notice related to the web interface (Office Action, p. 12, ll. 6-10) found throughout the Final Office Action, and specifically as this element relates to claims 14 and 28. It is respectfully suggested that before the priority date of this Application, a web interface allowing users to remotely interact with service contract information and thereby modify the triggering threshold was not capable of instant and unquestionable demonstration as being well-known. Appellants have therefore "specifically point[ed] out the supposed errors in the Examiner's action." MPEP 2144.03(C).

Additional Claims: In a number of the dependent claims, it is respectfully suggested that the Examiner improperly used Official Notice. The MPEP provides that Official Notice without documentary evidence is only appropriate in "**rare**" cases, a caveat that was not followed in this instance. MPEP §2144.03(A). The Examiner has attempted to take Official Notice related to aspects of the claims related to wireless communications (claims 3, 4, 10, 19, 20, and 21), the web interface (claims 5, 14, and 26), and automating monitoring functions (claims 6 and 23). This Official Notice is traversed. For at least the reasons set forth above related to the independent claims, these aspects of the claims are "not capable of instant and unquestionable demonstration as being well-known."

As the cited reference and Official Notice fail to teach or suggest all of the recitations of independent claims 14, 22, and 28, Appellants submit that these claims are allowable. Claims 17-21, 23, 24, and 26, which depend from these independent claims, are allowable for at least the same reasons. Claims 3-6, 10, and 11 are also allowable for the reasons cited above. Therefore, Appellants respectfully request that the rejections to claims 3-6, 10, 11, 14, 17-24, 26 and 28 be reversed.
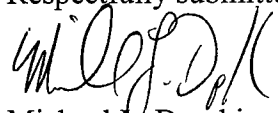
8. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections should each be reversed.

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9. CLAIMS APPENDIX

1.   (Previously Presented)   A method for automating management of a service contract for a business machine associated with a user, the method comprising steps of:

providing a data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof;

automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a predetermined time period, and any combination thereof;

programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event;

receiving notification from the data capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification; and

reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step.

2.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising a step of receiving a service call by a technician automatically generated from user input.

3.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising a step of wirelessly notifying a technician of a service call for the business machine.

4.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 3, further

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comprising a step of contacting the user by the technician based upon the wirelessly notifying step.

5.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising a step of receiving service contract information from user by way of a web interface for an operations center.

6.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising steps of:

determining if automatic contract renewals are authorized, and

automatically renewing the service contract if authorized.

7.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, wherein the programming step includes a step of programming the threshold event into the data capture device from a point remote to the data capture device.

8.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, wherein the determining step is performed at a point remote to the data capture device.

9.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, wherein the data capture device includes a mechanism for placing a service request when manually activated.

10.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, wherein the data capture device comprises a wireless transceiver.

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11.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, wherein the threshold event is one of the following:

a first percentage of a contract period; and

a second percentage of a contract usage.

12.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising a step of querying the data capture device for information.

13.   (Previously Presented)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 1, further comprising steps of:

remotely monitoring usage of supplies; and

notifying the user when ordering of supplies is predicted to be warranted.

14.   (Previously Presented)   An automated business machine management system for business machines of users, the automated business machine management system comprising:

a plurality of data capture devices, wherein:

each data capture device is coupled to an associated business machine, each associated business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof, and

each data capture device comprises a wireless transceiver;

an operations center in two-way communication with each of the plurality of data capture devices, wherein the operations center determines a threshold related to a service contract and communicates that threshold to one of the plurality of data capture devices, the threshold comprising a selection from the group consisting of a usage count for the business machine, a level of supplies for the business machine, a predetermined time period, and any combination thereof; and

a web interface to the operations center, wherein:

the web interface is remote to the operations center, wherein the web interface

allows users to remotely interact with service contract information and thereby modify the

threshold.

15-16. (Canceled)

17.   (Previously Presented)   The automated business machine

management system for business machines of users as recited in claim 14, wherein a plurality of

service technicians are assigned to the plurality of business machines.

18.   (Original)   The automated business machine management system for

business machines of users as recited in claim 14, wherein each of the plurality of data capture

device is integral to its associated business machine.

19.   (Original)   The automated business machine management system for

business machines of users as recited in claim 14, further comprising a plurality of wireless

service terminals that receive service calls for the plurality of business machines.

20.   (Previously Presented)   The automated business machine

management system for business machines of users as recited in claim 14, wherein at least one of

the plurality of data capture devices comprises a mechanism for wirelessly requesting a service

call.

21.   (Previously Presented)   The automated business machine

management system for business machines of users as recited in claim 14, wherein:

        at least one wireless transceiver is coupled to a data center transceiver,

        the data center transceiver is coupled to a wide area network, and

        the wide area network is coupled to the operations center.

22.   (Previously Presented)   A method for automating management of a

service contract for a business machine associated with a user, the method comprising steps of:

providing a data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof;

automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a level of supplies for the business machine, and a combination thereof;

programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event;

receiving notification from the data capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification;

wirelessly notifying a technician to service the business machine, wherein the wireless notifying occurs automatically in response to the notification from the data capture device.

23.   (Previously Presented)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 22, further comprising a step of:

reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step.

24.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 23, wherein the threshold event is a malfunction in the business machine.

25.   (Canceled)

26.   (Original)   The method for automating management of the service contract for the business machine associated with the user as recited in claim 22, further

comprising a step of receiving service contract information from user by way of a web interface for an operations center.

27.   (Canceled)

28.   (Previously Presented)   An automated business machine management system for business machines of users, the automated business machine management system comprising:

a plurality of data capture devices, wherein:

each data capture device is coupled to an associated business machine, each associated business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof,

each data capture device is configured to monitor its associated business machine and to log monitored events; and

each data capture device comprises a wireless transceiver;

an operations center in two-way communication with each of the plurality of data capture devices, wherein the operations center is configured to:

determine a threshold which triggers a service to be performed by a technician pursuant to a service contract, the threshold comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a level of supplies for the business machine, a predetermined time period, and any combination thereof;

communicates that threshold to one of the plurality of data capture devices;

receive wireless notification from the one data capture device that the threshold was logged by the one data capture device, triggering the notification; and

wirelessly notify the technician to service the associated business machine, wherein the wireless notifying occurs automatically in response to the notification from the data capture device; and

a web interface remote to the operations center, wherein the web interface allows users to remotely interact with service contract information and thereby modify the threshold.

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10. EVIDENCE APPENDIX

None

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11. RELATED PROCEEDINGS APPENDIX

None